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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/500,191	06/25/2004	Masahiro Sano	Q82273	9237
23373 7590 12/03/2007 SUGHRUE MION, PLLC 2100 PENNSYLVANIA AVENUE, N.W. SUITE 800 WASHINGTON, DC 20037			EXAMINER KNABLE, GEOFFREY L	
			ART UNIT 1791	PAPER NUMBER
			MAIL DATE 12/03/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/500,191	Applicant(s) SANO, MASAHIRO	
	Examiner Geoffrey L. Knable	Art Unit 1791	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a): In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 September 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

1. It is first noted that the last two lines of claim 1 as amended include significant changes from the previous claim language without proper strikethrough and/or underlining, the presented underlining and strikethrough bearing little correspondence with the previous language. However, in the interest of expediting prosecution, this claim will be examined as currently presented.

2. Claims 1-14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 1 and 3 have been amended to define the "tops of the decorative portion protruding higher than the level of the sidewall on which the decorative portion is arranged" - new claim 8 includes this same language. To the extent that this requirement is being read in a manner that it is argued it distinguishes the previously applied prior art, this represents subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention, i.e. it is considered to be new matter. In particular, if read as simply defining in essence no more than that the tops of the decorative portion (i.e. serrations) are higher than the bottoms thereof (the bottom then being the level of the sidewall from which the decorative portion protrudes - e.g. line X in fig. 2), then it would not be disputed that such is described and supported. It appears however that applicant is

reading this in a more restrictive or at least different manner as related to the somewhat amorphous and undefined "level of the sidewall on which the decorative portion is arranged" and there is no original descriptive support for such a new requirement at least as read as requiring anything more than that the tops of the serrations are higher than the bottoms thereof. Note that the serrations/decorative portion themselves define the level of the sidewall of the tire - they cannot protrude further from themselves. The only level originally described is the level of the bottoms of the serrations.

Claim 2 has been amended to now define that the high decorative portion is joined to "at least one of the joined portions", these joined portions being defined in claim 1 as being those portions that "join the protruding portions and the decorative portion" (and *not* the joined portions of the protruding portions). As noted and advised in the last office action, amending claim 2 to define that this high decorative part is on the "joined portion" of protruding portion and decorative portion as defined in claim 1 as amended, as opposed to the joined portion of protruding portions (e.g. fig. 6) as originally disclosed, would lack original descriptive support. This new requirement however goes further in also defining not that the high decorative portion is provided "on" the joined portion (i.e. in essence coincident thereto) but rather is "joined to" the joined portion (and thus apparently in addition to the joined portion), this creating significant confusion in distinguishing joined portions from the decorative portions. It is also now defined that the "high decorative portion" is part of the previously defined "decorative portion". This new inclusion of the "high decorative portion" within the "decorative portion" makes it even more confusing to now determine what is a joined

portion. Note for example if the high decorative portion is part of the decorative portion and the joined portions join decorative portions to the protruding portions, what exactly is a joined portion? This is particularly confusing when read in light of the new claim 8 requirements which indicate that what is termed a joined portion can have both tops and bottoms. In addition to being entirely confusing in assessing the scope thereof (to be addressed in following rejection), this lacks any reasonable descriptive support in the original disclosure. This therefore is considered to contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention, i.e. it is considered to represent new matter.

New claims 10, 12 and 14 define that the decorative portion "defines a pattern that does not comprise a group of letters". This new negative limitation lacks any literal explicit basis in the original disclosure and it is not seen where implicit support thereof is found. The original disclosure only discloses a series of serrations constituting the decorative portion, there not being any clear original indication that the invention with respect to the decorative portion was characterized by any pattern thereof as long as not a group of letters. For example, this new language would indicate that the decorative portion could be a group of numbers, there being no indication that the decorative portion was to be so characterized. This recharacterizing the invention with respect to the negative limitation on the patterning of the decorative portion is therefore considered to represent subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the

inventor(s), at the time the application was filed, had possession of the claimed invention, i.e. it is considered to be new matter.

3. Claims 1-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

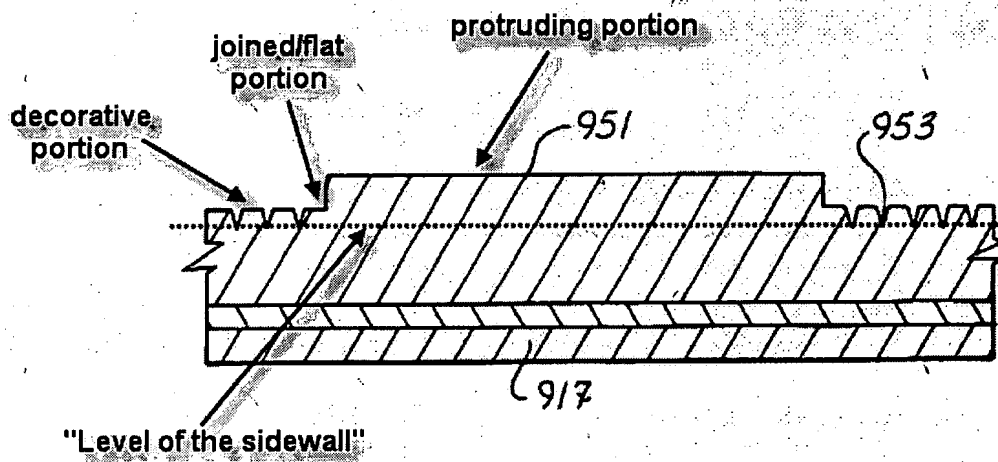
Along somewhat similar lines to that described in the preceding rejection, with the amendment to claim 2 defining that the decorative portion includes the high decorative portion, this being joined to the joined portion, it is now not understood exactly what a "joined portion" comprises and how it is distinguished from a decorative portion, this reference to "joined portions" being present in both independent claims 1 and 8 as well as dependent claims 2 and 7. Note that it is critical to understand the scope of protection afforded by these claims to be able to ascertain exactly what a "joined portion" comprises and how it compares to a "decorative portion" and this latest amendment now makes it very difficult to make any definite conclusion in this regard. Note further that claim 8 defines that the joined portions have bottoms and tops - how is this to be distinguished from the originally disclosed "high decorative portion" which, in view of claim 2, is to be considered part of the decorative portion and explicitly distinct from a "joined portion". Clarification is required of exactly what comprises a decorative portion and what comprises a joined portion and how the artisan is to be able to determine the boundaries of each. Pointing to the exemplary embodiments illustrated in the drawings to show exactly where or how each portion is defined might be helpful to an understanding of this now very ambiguous concept.

With the removal from the independent claims of the defining direction of "tops" and "bottoms," it is once again not clear what this requires, it being noted that the term "top" and "bottom", in the context of a tire can have very different meanings and without knowing what direction this is relative to, this requirement is once again entirely indefinite and confusing. Note that the claim only relates the tops to the sidewall but now does not indicate that this is the defining relative direction for the top and bottoms (as the previous amendment had done but which is now no longer in the claims).

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claims 1, 3 and 9-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Kemp et al. (US 6,253,815).

As to claim 1, Kemp et al. is applied for substantially the same reasons as set forth in the last office action. As to the new requirement that tops of the decorative portion protrude higher than a level of the sidewall, note the marked up figure 2 which has been further marked to show why this is still considered to be met:



(PRIOR ART)
Fig. 2

Note that the tops of the decorative portion protrude higher than what is considered the level of the sidewall. A tire as required by claim 1 is therefore anticipated by this disclosure. As to the new requirement in claim 3 that the flat portions are provided between protruding portions, given that the tire includes multiple letters (which are the protruding portions - note fig. 1), the indicated flat portion would be located between protruding portions for areas between letters. A tire as required by claim 3 is therefore still considered to be anticipated by this disclosure as well. As to claims 9-12, note that the protruding portions comprise letters and the adjacent serrated portion does not comprise letters.

6. Claims 2 and 7/2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kemp et al. (US 6,253,815) as applied above, and further in view of Roberts et al. (US 4,198,774) as applied in the last office action.

7. Claim 7/1 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Kemp et al. (US 6,253,815) as applied in the last office action.

8. With the amendment to claim 3 to define that the flat portions are between protruding portions rather than between the decorative portion and protruding portions, and with the presentation of new claim 8, the following rejections are also now applicable (note that D204585 to Vizina was previously applied but with this amendment, is once again applicable).

9. Claims 3-4, 7, 11 and 12 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over D204585 to Vizina.

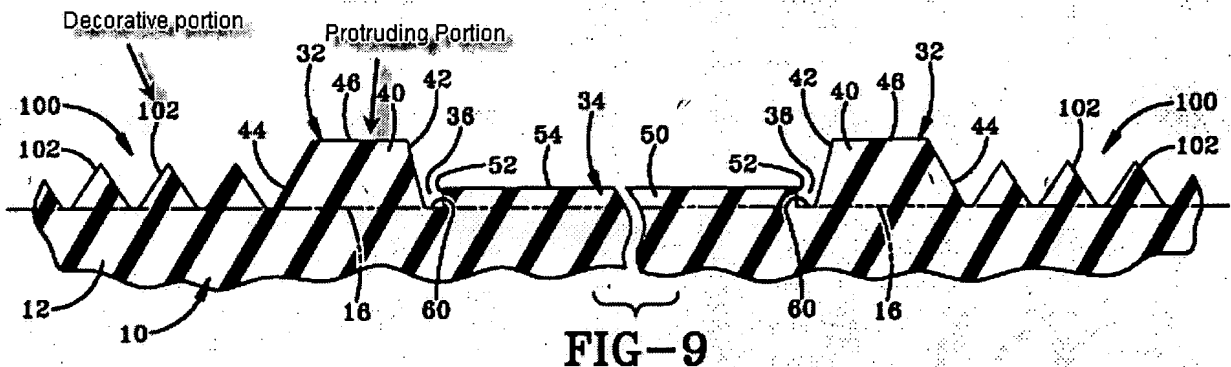
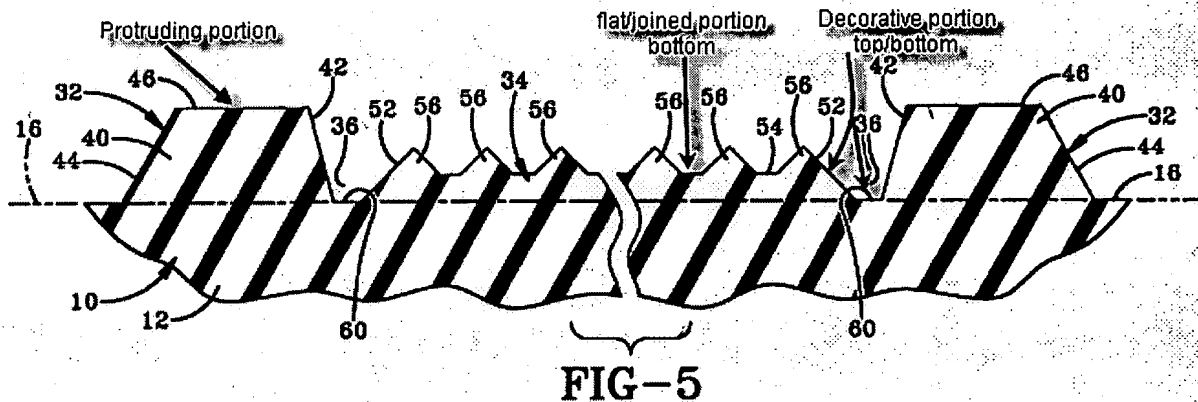
Vizina discloses a tire including a sidewall having a serrated background pattern (e.g. note various cross-sections) defining what is considered to be a decorative portion having interconnected tops and bottoms in the protruding direction; the bottoms of the serrations being reasonably considered a "level of the sidewall" from which the serrations protrude. Further, protruding portions higher than the tops of the decorative portions are provided in the pattern (esp. fig. 5) with a flat portion between adjacent protruding parts (i.e. the flat part between each of the two raised portions in fig. 5) being higher than the bottoms of the decorative portion (e.g. note again esp. fig. 5). This reference is therefore considered to anticipate what is defined in claim 3, the ambiguities already noted however preventing a complete and accurate comparison, any differences however being considered obvious optimizations of this basic teaching. As to claim 4, the parts between adjacent protruding parts are flat and can be said to

suggest or render obvious the claim 4 relative dimensions reading the dimension of the protruding ends as being from for example the outer ends thereof. As to claim 7, the illustrated relative dimensions are considered to suggest or certainly render obvious relative heights within the broadly claimed range, it being stressed that the illustrated design being a design patent would have been read to be a more accurate representation of how the final structure should be relatively configured. As to claims 11 and 12, note that the protruding portions define a group of letters "L" (fig. 2) while the serrated decorative portion does not comprise letters.

10. Claims 3, 4, 8 and 11-14 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Baker (US 6,053,228).

As to claim 3, Baker discloses a tire including a sidewall that includes what can be termed a decorative portion that includes tops and bottoms (either parts 52/60 in fig. 5 or part 100 in fig. 9) as well as protruding portions (46) higher than either decorative portion. Further, flat portions (54) higher than bottoms (16) of the decorative portion are provided between protruding portions. As to claim 8, the bottom (54) is higher than the bottom (16) of the decorative portion and the top (top of 56) is lower than protruding portions 46. Both claims 3 and 8 are therefore considered to be anticipated by Baker, the ambiguities already noted however preventing a complete and accurate comparison, any differences however being considered obvious optimizations of this basic teaching. With respect to claim 8, it is also noted that an obvious alternative would also be to include the decorative portion (100) from fig. 9 with the internal serrated joined portion 54/56 of fig. 5, in such case, the decorative portion can also be

considered the part 100, although at present the claims do not seem to require such a distinction as the "decorative portion" is very broadly defined. Note the following marked up copies of the relevant figures to help illustrate this:



As to claim 4, the parts between adjacent protruding parts are flat and can be said to suggest or render obvious the claim 4 relative dimensions especially reading the dimension of the protruding ends as being from for example the *outer* ends thereof. As to claims 11-14, the protruding portions form letters and the decorative portions do not.

11. Claims 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kemp et al. (US 6,253,815) or D204585 to Vizina or Baker (US 6,053,228) as applied above, and further in view of JP 2000-255224 (cited by applicant) and optionally Ratliff, Jr. (US 5,807,446) as applied in the last office action.

12. Applicant's arguments filed 9-20-2007 have been fully considered but they are not persuasive.

Most of the arguments with respect to the 112 rejections are either moot or have been treated within the statements of rejection above. It is noted in particular with respect to claim 2 that although applicant removed "of the joined portions" from claim 2, the antecedent for "the joined portions" is thus from claim 1 which only refers to the joined portions joining the protruding portions and decorative portion. To make this consistent with fig. 6, the high decorative portion has been redefined as not being the actual joined portion (as originally described/claimed) but rather another decorative portion, the "joined portion" then apparently being essentially only the bottom 19. However, from for example new claim 8, it is apparent that joined portions can have both bottoms and tops (rather than being for example only part 19 of fig. 6) - it therefore is not clear now how one knows what constitutes a "joined portion" and what constitutes a decorative portion, this creating significant ambiguity. It is important that these concepts be clearly understood and delineated as the entire patent scope depends on the meaning of these rather amorphous terms.

With respect to the prior art, applicant has stressed the requirement that the decorative portion tops protrude higher than the level of the sidewall. For reasons

detailed within the statement of rejection, however, this is unpersuasive. In particular, it is noted that the decorative portion itself forms the sidewall and the bottoms of the decorative portion are at a level of the sidewall from which the decorative portions protrudes. To the extent that applicant is reading this requirement as being any more restrictive, a lack of description/new matter rejection was necessitated as detailed above.

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Geoffrey L. Knable whose telephone number is 571-272-1220. The examiner can normally be reached on M-F.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on 571-272-1226. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Geoffrey L. Knable
Primary Examiner
Art Unit 1791

G. Knable
November 29, 2007